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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,920	02/07/2001	Jacques Dumas	BAYER 15 P3	6183
23599	7590	12/02/2004	EXAMINER DESAI, RITA J	
MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			ART UNIT 1625	PAPER NUMBER

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/777,920

**Applicant(s)**

DUMAS ET AL.

**Examiner**

Rita J. Desai

**Art Unit**

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22, 24-30, 34-37, 39, 40, 42 and 45-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22, 24-30, 34-37, 39, 40, 42, 45-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

The request filed on 9/23/2004 for a Continued Examination Application (RCE) under 37 CFR 1.114 based on parent Application No. 09/777,920 is acceptable and a RCE has been established. An action on the RCE follows.

Claims 1-22, 24-30, 34-37, 39, 40, 42, 45-48 are pending.

#### *Election/Restrictions*

Applicants have not amended the claims to the elected group.

The restriction is drawn to the following group

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 31-33 and 1-30 in part, drawn to compounds, pharmaceutical compositions and method of treating wherein the compounds B is a quinoline, isoquinolinyl or a pyridyl moiety, A is a group wherein q is 1, M is O, L is a phenyl and L' is a phenyl or a 5 or 6 membered hetero ring containing Nitrogen only, classified in class 546, 514 subclass 152, 180, 277.4, 277, 311, 312-314.

as given in the office action dated 1/15/2002.

The claims still include other groups for M and also for L, L'.

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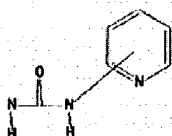
Applicant's election with traverse of the restriction in Paper No. 6 is acknowledged.

The traversal is on the ground(s) that the full scope of the claims would not be burdened since

B is a pyridyl or a quinoline moiety, that the restriction to limit to the L' as given in claim 8.

The claims 37-48 have non-elected subject matter and are drawn to a different scope.

This is not found persuasive because with an ureido group and the pyridyl there were numerous hits and hence is not applicant's contribution over the prior art!



> S II

SAMPLE SEARCH INITIATED 17:22:19 FILE 'REGISTRY'

SAMPLE SCREEN SEARCH COMPLETED - 2101 TO ITERATE

47.6% PROCESSED 1000 ITERATIONS 50 ANSWERS

INCOMPLETE SEARCH (SYSTEM LIMIT EXCEEDED)

SEARCH TIME: 00:00:01

FULL FILE PROJECTIONS: ONLINE \*\*COMPLETE\*\*

BATCH \*\*COMPLETE\*\*

PROJECTED ITERATIONS: 39272 TO 44768.

The requirement is still deemed proper and is therefore made FINAL.

Applicant is required to amend the claims to the elected group.

The rejection of the claims 1, 2, 6, 17, 19, 20 and 37 (38 and 44 are cancelled) under 35 USC 112 written description still stands. The description is vague and does not reasonably convey that the applicants had possession of the claimed invention.

The core and also the substituents are described as groups of 1-24 or 1-30 carbon atoms or 1-40 carbon atoms with various substituents which are also just as vaguely defined.

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There is no description of definition for these groups in the specification. There are some examples but the description is not there.

Applicants can overcome this by inserting the specific exemplified groups in the claims.

The rejection of claims 1-22, 24-30, 34-37, 39, 40, 42, 45-48 under 35 USC scope of enablement still stands since the claims simply state containing hetero atoms O, N, S, the specification do not have any guidance to which groups they are and how and where these groups are linked. There are numerous hetero groups and because of their bonding and groupings they have different properties hence any and all groups cannot be substituted without any undue experimentations.

The rejection of claims 39 and 41 under 35 USC 112 second para has been withdrawn since applicants have amended the claims.

New rejections

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 29, 30, 36 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite treating cancerous cells but does not indicate which cancerous cell.

The claim does not specify which cancer is treatable. All cancers are not treatable in the same way. Applicants should specify which cancerous cell is treatable.

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### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-22, 24-30, 34-37, 39, 40, 42, 45-48 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/788029, 10/895985, 09/899,227. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are drawn to the same genus.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

The claims are not allowable.

Applicants have several co-pending applications and should have a clear line of demarcation of the claims so as to avoid double patenting.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, 9:30 am to 6:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rita J. Desai  
Primary Examiner  
Art Unit 1625

*RDesai*  
12/1/04

R.D.  
December 1, 2004